



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,839	12/01/2000	Reinhard Storbeck	BEIERSDORF 671-WCG	4244

7590 08/16/2002
Norris McLaughlin & Marcus, P.A.
Attorneys at Law
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 08/16/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/26/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- ☐ Claim(s) _____ is/are withdrawn from consideration.
- Of the above claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☒ Claim(s) 1-17 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.
- ☐ Claim(s) _____

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 7
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Part of Paper No. 10

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberg, taken either individually, or in view of the Handbook of Adhesives, 2nd Edition (1977) chapter 47, substantially for the reasons set forth in paragraph No. 2 of Paper No. 5, together with the following additional observations. Applicant argues, in essence, that one of ordinary skill in the art would see no equivalence at all between the use of a film, as opposed to a paper backing in applicant's claimed genus of adhesive tapes. However, the Examiner must respectfully disagree, since he believes that applicant's arguments in effect completely ignore the very high level of ordinary skill in the adhesive tape art. Applicant's arguments (Response, pages 3-4) concerning the non-equivalence of paper as opposed to the use of film backings is seen to be unwarranted speculation in view of the cited Handbook teaching of their general equivalence and the availability of methods to improve paper backings "internal strength (ply strength or delamination resistance)" - see page 725, column 1, bottom paragraph. Note also that while the Handbook reference does not expressly teach the initial equivalence of paper versus film backings, page 725 is filled with techniques to change the physical properties of whatever type of backing is selected so as to arrive at a desired set of

Art Unit 1771

end properties after employing a variety of techniques well known to one of ordinary skill in the art. As to Weinberg's teachings (column 1, line 48) of using a paper backing, it is a teaching that hardly would be described as "quite emphatic" in the Examiner's strong opinion.

3. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending applications Nos. 09/518,463 or 09/490,709 in view of the Handbook of Adhesives, 2nd Edition (1977) Chapter 47, substantially for the reasons set forth in paragraph No. 4 of Paper No. 5, together with the following observations. The rationale for the Examiner's position, and the argument presented by applicant are essentially identical as that set forth in the preceding paragraph so no further amplification is needed.

This is a *provisional* obviousness-type double patenting rejection.

4. Claims 1-17 are provisionally rejected under 35 U.S.C. § 103(a) as being obvious over copending Application No. 09/518,463 or 09/490,709 which has common co-inventors with the instant application, each in view of the Handbook of Adhesives reference, substantially for the reasons set forth in paragraph No. 6 of Paper No. 5. As with the prior provisional rejection, the rationale of the Examiner's rejection and the traversal by

Art Unit 1771

applicants of this rejection are each substantially identical to their positions set forth above. Accordingly, no further amplification is seen to be necessary.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner

Serial No. 09/728,839

-5-

Art Unit 1771

can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

August 13, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1500~~
1700

Daniel Zinker